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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,993	05/11/2006	Eugene Sherry	5000-061503	5104

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EXAMINER
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JOHNSON, AMY COHEN

ART UNIT	PAPER NUMBER
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2841

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,993	<b>Applicant(s)</b> SHERRY ET AL.	
	<b>Examiner</b> Amy Cohen Johnson	<b>Art Unit</b> 2841	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-22 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-22 and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 25-27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 25-27 fail to further limit the independent claims from which they depend since, they are directed to functional language and since they only further define the preamble of the claims, wherein the preamble in apparatus claims is not given patentable weight.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-22, 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fishbane (U. S. Patent No. 5,122,145) in view of Shue et al. (U. S. Patent No. 2,385,424).

Fishbane discloses a gauge (2) for use in a surgical procedure to determine a first angle in a first plane (Figs. 1-3, Col 1, lines 19-34), said gauge comprising: a body (8); a level (10) mounted to said body so as to be under the influence of a local gravitational field, said level being mounted so as to determine a first angle (Figs. 1-3, Col 2, lines 25-42, Col 3, lines 45-60, Col 4, lines 10-16); and a connector (4, 6) disposed on said body for mounting of said gauge to a prosthetic component and a predefined site of a patient to allow correlation between the

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predefined site of said patient and positioning of said prosthetic component (Figs. 1-3, Col 1, lines 19-34, Col 2, lines 4-64, Col 3, lines 19-60).

Fishbane discloses the gauge wherein said surgical procedure is the insertion of an acetabular cup into a reamed acetabulum during hip replacement surgery (Col 1, lines 19-59).

Fishbane does not disclose the gauge comprising a plumb bob mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both a first plane and a second plane so as to determine a first angle and a second angle; wherein a universal joint rotatably mounts said plumb bob to said body; wherein said universal joint is any one of: a ball joint (22) (Col 3, lines 18-27); a singular pivot-point joint (13) (Col 2, lines 37-46); an eye end joint; a tie rod joint; or a rose joint; wherein said first plane is orthogonal to said second plane; wherein said plumb bob includes a pointer; wherein said body includes markings disposed adjacent said pointer; wherein a first sub-set of said markings corresponds to angular increments of said first angle and a second sub-set of said markings corresponds to angular increments of said second angle; wherein movement of the plumb bob relative to the body is damped.

Shue et al. discloses a gauge wherein the level is a plumb bob (Figs. 1-3) mounted to said body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in both said first plane and said second plane so as to determine said first angle and said second angle respectively (Col 1, lines 5-13, Col 2, lines 4-46); wherein a universal joint rotatably mounts said plumb bob to said body (Col 2, lines 30-46); wherein said universal joint is any one of: a ball joint (22) (Col 3, lines 18-27); a singular pivot-point joint (13) (Col 2, lines 37-46); an eye end joint; a tie rod joint; or a rose joint; wherein said first plane is orthogonal to said second plane (Col 1, lines 5-13); wherein said plumb bob includes a pointer (14); wherein said body includes markings (20) disposed adjacent said pointer; wherein a first

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sub-set of said markings corresponds to angular increments of said first angle and a second sub-set of said markings corresponds to angular increments of said second angle (Fig. 1, Col 3, lines 3-17); wherein movement of the plumb bob relative to the body is damped (damped by weight 15 or 15a, Col 2, lines 44-46, Col 3, lines 33-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the spirit level of Fishbane with a plumb bob, as taught by Shue et al., in order to more accurately indicate an angular position with the use of a pointer and angle scale and in order to determine the angle with respect to two perpendicular axis, increasing the accuracy of the apparatus.

Regarding claims 25-27: Claims 25-27 are directed to functional language which does not further limit the independent claim from which the claims depend. Therefore, the subject matter of these claims is considered to be intended use of the apparatus and, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). See MPEP 2106 and 2111.04.

4. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (U. S. Patent No. 5,314,432) in view of Arthur (U. S. Patent No. 1,495,629).

Paul discloses a gauge (10) for use in a surgical procedure to determine a first angle in a first plane and a second angle in a second plane (Figs. 1-9), said gauge comprising: a body (20); a first level (26) mounted to said body so as to act under the influence of a local gravitational field, said first level being mounted so as to determine said first angle; a second level (27) mounted to said body so as to hang under the influence of a local gravitational field, said second level being mounted so as to determine said second angle (Figs. 1, 3-9, Col 3, lines 44-54); a

connector (36) disposed on said body for connection of said gauge to a predetermined site of a patient (Figs. 1, 7, 9, Col 3, line 44-Col 4, line 7).

Paul does not disclose the gauge wherein said first level is a first plumb bob and wherein said second level is a second plumb bob; wherein said first plumb bob is mounted to said body for rotation about a first axis and the second plumb bob is mounted to said body for rotation about a second axis, whereby said first axis is orthogonal to said second axis.

Arthur discloses a gauge wherein the level is a plumb bob (19) which is mounted to a body so as to hang under the influence of a local gravitational field, said plumb bob being rotatable relative to said body in a first plane so as to determine said first angle (Fig. 1, Col 2, lines 60-101); wherein said plumb bob is mounted to said body for rotation about a first axis (Fig. 1, Col 2, lines 60-101).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the spirit levels of Paul with plumb bobs, as taught by Arthur, in order to more accurately indicate an angular position with the use of a pointer and angle scale (Arthur, Col 1, lines 9-29).

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 16-22, 25-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 161-193 of copending Application No. 10/494085. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to a gauge for use in a surgical procedure comprising a plumb bob wherein the surgical procedure is a hip replacement surgery.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 16-22, 25-28 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant provided no arguments with respect to the rejection of claims 29-30, therefore, the rejection is repeated herein.

9. Regarding Applicant's arguments regarding the double patenting rejection, Examiner disagrees. The double patenting rejection is proper pursuant MPEP 804 I. B. 1; wherein the provisional double patenting rejection should be maintained unless it is the only rejection remaining in the earlier filed application, in which case, it will be withdrawn.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Cohen Johnson whose telephone number is (571)272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A. Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. Bradley Bennett/  
Primary Examiner, Art Unit 2841

ACJ  
June 9, 2008